

### **REMARKS/ARGUMENTS**

The Office Action mailed December 13, 2004 has been carefully considered.

Reconsideration in view of the following remarks is respectfully requested.

Applicants gratefully acknowledges and thanks the Examiner for the kind allowance of Claims 29-41. Claims 7 and 13-15 have been amended to overcome the 35 U.S.C. §112 issues. No new matter has been added.

#### **Claim Objections**

A. Claim 7 stands objected to because the “claim recites the use of ‘a tapered shape’ in line 2 of the claim. However, in Claims 8-10, of which depend upon Claim 7, recite ‘the tapered surface.’” Claim 7 have been amended to read “the tapered surface”.

B. Claims 13-15 stands objected to because the “claims utilize claim language such as ‘is made of’, which constitutes product-by-process language. In order to overcome the objection, the claim language should be changed to ‘comprises’.” Claims 13-15 have been amended to read “comprises” as suggested by the Examiner.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance. It is respectfully requested that this objection be withdrawn.

#### **The First 35 U.S.C. § 103 Rejection**

Claims 1-6, 11 and 16-18 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Cragg et al (USP 6,162,192, hereinafter ‘192), among which Claim 1 is an independent claim. This rejection is respectfully traversed.

According to M.P.E.P. §2136.02, “[f]or applications filed on or after November 29, 1999, if the applicant provides evidence that the application and prior art reference were ... subject to an obligation of assignment to the same person, ... any rejections under 35 U.S.C. 103 based upon such a commonly owned reference should not be made or maintained.”

USP 6,162,192 and the present application, were, at the time the invention was made, owned by, or subject to an obligation of assignment to the same entity, Sub-Q, Inc. The assignment for ‘192 is located on Reel/Frame 9371/0797. The assignment for the present application to Sub-Q, Inc. is located on Reel/Frame 013580/0626.

Accordingly, it is respectfully requested that this rejection be withdrawn.

#### The Second 35 U.S.C. § 103 Rejection

Claims 25, 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Janzen (5,437,631) in view of Fowler (5,601,602), among which Claim 25 is an independent claim. This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.<sup>1</sup>

Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in Janzen except that Janzen does not teach “an elongated member having

a distal end, a proximal end, and a means at the distal end for locating the blood vessel puncture by capturing an edge of the blood vessel puncture.” The Office Action further contends that Fowler teaches “a means for sealing a blood vessel puncture and further disclose an elongated member having a distal end, a proximal end, and a means at the distal end for locating the blood vessel puncture by capturing an edge of the blood vessel puncture. See Figures 7 and 8; and Column 6, lines 3-12” and that it would be obvious to one having ordinary skill in the art at the time of the invention to modify Janzen into Fowler in order to provide a means for locating as well as anchoring the device during the procedure. The Applicants respectfully disagree for the reasons, among others, set forth below. Upon a closer reading of Janzen, there are subtle but important differences between Fowler and the claimed invention.

Claim 25 provides for:

A device for determining a depth of an incision that extends from an epidermal layer to a blood vessel puncture site, the device comprising:

an elongated member having a distal end, a proximal end, and means at the distal end for locating the blood vessel puncture site by capturing an edge of the blood vessel puncture; and

a control member extending from the distal end of the elongated member and configured to be received in the puncture site.

As stated in the Office Action, Janzen does not teach “an elongated member having a distal end, a proximal end, and a means at the distal end for locating the blood vessel puncture by capturing an edge of the blood vessel puncture” and cites Figures 7-8 and Col. 6, lines 3-12 of Fowler as evidence of this limitation. However, upon a closer review of the figures and citation, the figures do not illustrate the elongated member of Fowler capturing an edge of the blood vessel puncture and in fact, the elongated member actually fully enters the blood vessel as illustrated in Fig. 8. Thus, Fowler does not teach nor discuss “an elongated member having a

distal end, a proximal end, and means at the distal end for locating the blood vessel puncture site by capturing an edge of the blood vessel puncture” as claimed in Claim 25.

Accordingly, since Janzen and Fowler do not teach or disclose an “elongated member having a distal end, a proximal end, and means at the distal end for locating the blood vessel puncture site by capturing an edge of the blood vessel puncture” as claimed in Claim 25, they can not be said to render the claimed invention obvious. It is respectfully requested that this rejection be withdrawn.

#### The Third 35 U.S.C. § 103 Rejection

Claims 42 and 43 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tay et al. (6,063,085) in view of Cragg et al. (6,162,192), among which Claim 42 is an independent claim. This rejection is respectfully traversed.

As stated above, USP 6,162,192 and the present application, were, at the time the invention was made, owned by, or subject to an obligation of assignment to the same entity, Sub-Q, Inc. The assignment for ‘192 is located on Reel/Frame 9371/0797. The assignment for the present application to Sub-Q, Inc. is located on Reel/Frame 013580/0626.

Accordingly, it is respectfully requested that this rejection be withdrawn.

#### Dependent Claims

As to dependent claims 2-24, 26-28, 30-41, and 43, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance. It is respectfully requested that this rejection be withdrawn.

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

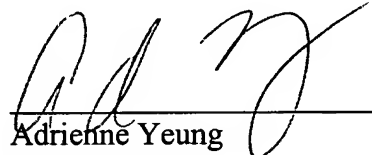
If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

THELEN REID & PRIEST, LLP

Dated: April 12, 2005

  
Adrienne Yeung  
Reg. No. 44,000

Thelen Reid & Priest LLP  
P.O. Box 640640  
San Jose, CA 95164-0640  
Tel. (408) 292-5800  
Fax. (408) 287-8040